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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/05/2000

Donny Ray Jenkins

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EXAMINER

CIRIC, LJILJANA V

ART UNIT

PAPER NUMBER

3753

DATE MAILED: 07/06/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,698

Applicant(s)

JENKINS, DONNY RAY

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the species illustrated in Figure 10 and the subspecies illustrated in Figure 3 (readable on claims 21, 22, 31, and 32) in the reply filed on January 5, 2004 is acknowledged. The traversal is on the ground(s) that the examiner could conceivably find the invention of Figure 10 patentable or not on the basis of the heating/cooling unit without ever reaching the subject matter of claims 21 through 30. While this could conceivably have been a persuasive argument for asserting that the respective inventions of Figure 10 and of the subject matter of claims 21 through 30 ARE patentably distinct from each other, this argument is NOT found persuasive as a traversal of the restriction requirement posed by Examiner Atkinson in Paper No. 7 because applicant's arguments fail to distinctly and specifically point out why the identified species are NOT patentably distinct from each other; on the contrary, arguments supporting patentable distinctness *support* the examiner's requirement to restrict.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 23 through 30 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species or inventions, there being no *allowable* generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 5, 2004.

3. NOTE: Following applicant's amendment to the claims filed on January 5, 2004, there IS a *generic* claim (claim 21) but no *allowable* generic claim.

Power of Attorney Revocation/Correction of Correspondence Address

4. Receipt and entry of the Power of Attorney Revocation/Correction of Correspondence Address filed on August 21, 2003 is hereby acknowledged.

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5. In response to applicant's comments regarding this matter, the examiner hereby notes that an inspection of the application file wrapper seems to indicate that the Power of Attorney Revocation/Correction of Correspondence Address filed on August 21, 2003 may have been matched with the file after the mailing of the election/restriction requirement directly to the applicant on October 27, 2003. The election/restriction requirement mailed on October 27, 2003 is Paper No. 8, and is listed in the Contents on the file wrapper *before* the Power of Attorney Revocation/Correction of Correspondence Address, Paper No. 9.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the adjacent portions of the continuous channel must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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7. Alternately, if the adjacent portions of the continuous channel are shown in the drawings, then the drawings are objected to because there is no reference number therein corresponding to the adjacent portions of the continuous channel. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The abstract of the disclosure is objected to because it does not avoid the terms and legal phraseology often reserved for patent claims (i.e., "comprising"). Correction is required. See MPEP § 608.01(b).

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there appears to be no antecedent basis in the specification for the adjacent portions as recited in the claims..

Claim Objections

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10. Claim 22 is objected to because of the following informalities: "being configured" [claim 22, line 2] should be replaced with "are configured" to improve readability and grammatical correctness.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 21, 22, 31, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Absent a proper antecedent basis in the specification therefor as previously noted herein and absent any corresponding reference numbers in the drawings, it is not clear to which particular structures or portions of the continuous channel the limitation "adjacent portions" [claim 21, line 6, and other occurrences] refers, thus rendering the intended scope of claim 21 and all claims depending therefrom indefinite.

The term "short" in claim 21 and all claims depending therefrom is a relative term which renders the claim indefinite. The term "short" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, as used to qualify the lengths of the passageways extending between corresponding adjacent portions of the flexible, continuous channel, this term renders the same indeterminate and the claims indefinite.

With regard to claim 21 as written, it is not clear whether or not the limitation "a fluid" as cited in each of lines 7, 8, and 14 and the limitation "fluid" recited in line 20 necessarily refer to a single fluid (i.e., to the same fluid), thus rendering indefinite the metes and bounds of protection sought by claim 21

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and claims depending therefrom. Claim 32 also recites “a fluid” in line 3 thereof and is similarly rendered indefinite thereby.

The limitations “such that a fluid flowing through said corresponding adjacent portions *normally substantially all bypasses* [sic] said short passageways” [claim 21, lines 14-16] appears to have a word or words missing therefrom and is thus generally incomprehensible as written, thus further rendering indefinite claim 21 and all claims depending therefrom. Claim 22 contains an almost identical set of limitations which is similarly generally incomprehensible as written.

Given that only the limitation “said short *passageways*” is previously cited in the claims, it is not clear, for example, whether the limitation “said short *passageway*” [claim 21, line 20] refers to a particular passageway of the plurality of such passageways previously cited (and if so, it is not clear which one) OR if it is merely a typographical error and is intended to refer to all of the previously cited short passageways.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. As best can be understood given the indefiniteness of the claims, claims 21, 22, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by *Larsen*.

Larsen discloses a body heating/cooling apparatus essentially as claimed, including, for example: a vest 10 comprising a front panel 11 and a back panel 12, the front and back panels 11 and 12 defining a cavity [see Figures 1 through 3, also, claim 3]; a flexible continuous channel 14 or 15 disposed in serpentine fashion throughout the cavity, the flexible continuous channel 14 or 15 having adjacent portions 51 and both fluid inlet means 16 and fluid outlet means 17 fluidly connected using fluid conduits to a compressor or pump 30 for placing the pump or compressor 30 in fluid communication with the flexible continuous channel 14 or 15 and with means in a unit box or frame 21 for controlling the temperature of the fluid being pumped through the flexible continuous channel 14 or 15. *Larsen* furthermore discloses short passageways or tubular straps 50 as connecting the adjacent portions of the flexible continuous channel [see column 3, lines 54-60]. Note that the claims of the instant application do NOT recite the short passageways as being in fluid communication with either the flexible continuous channel or with the adjacent portions thereof, for example. *Larsen*, just like the instant application, discloses that the means for controlling the temperature of the fluid being pumped through the flexible continuous channel 14 or 15 may be a refrigerator or refrigeration system.

The reference thus reads on the claims.

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15. Alternately and as best can be understood given the indefiniteness of the claims, claims 21, 22, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by *Elkins* (filed January 28, 2000)

Elkins discloses a body heating/cooling apparatus essentially as claimed, including, for example: a vest [see Figures 8 and 9] comprising a front panel and a back panel, the front and back panels defining a cavity; a flexible continuous channel disposed in serpentine fashion throughout the cavity, the flexible continuous channel having adjacent portions and both fluid inlet means 64 or 64' and fluid outlet means 66 or 66' fluidly connected using fluid conduits inside cord 17 [see column 3, lines 18-21] to a circulator or pump [see column 3, lines 28-32] within temperature control device 18 for placing the pump or circulator in fluid communication with the flexible continuous channel and with means for controlling the temperature of the fluid being pumped through the flexible continuous channel. *Elkins* furthermore discloses short passageways connecting the adjacent portions of the flexible continuous channel as broadly interpreted as required [see Figures 8 and 9]. *Elkins*, just like the instant application, also discloses that the means for controlling the temperature of the fluid being pumped through the flexible continuous channel may be a heat exchange unit (i.e., a refrigerator or refrigeration unit) disposed within the device 18 [see column 3, lines 28-47].

The reference thus reads on the claims.

16. Alternately and as best can be understood given the indefiniteness of the claims, claims 21, 22, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by *Bailey, Sr., et al.* ('501)

Bailey, Sr., et al. ('501) discloses a body heating/cooling apparatus essentially as claimed, including, for example: a vest [see column 24, lines 52-53; also column 32, lines 45-51] comprising a front panel and a back panel, the front and back panels defining a cavity; a flexible continuous channel disposed in serpentine fashion or maze 25 throughout the cavity [see Figure 7 or 8A], the flexible continuous channel having adjacent portions and both fluid inlet means 161 and fluid outlet means 160 fluidly connected using fluid conduits within a temperature control subsystem [see Figure 44, 45, 47, 48,

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and 49] for placing a pump 110 or 120 or 134 or 140 or 141 in fluid communication with the flexible continuous channel and with means for controlling the temperature of the fluid being pumped through the flexible continuous channel. *Bailey, Sr., et al.* furthermore discloses short passageways or blind pockets 51 connecting the adjacent portions of the flexible continuous channel as broadly interpreted as required [see Figures 7 or 8A]. *Bailey, Sr., et al.*, just like the instant application, also discloses that the means for controlling the temperature of the fluid being pumped through the flexible continuous channel may be, for example, a refrigerator or refrigeration system as shown in Figure 44 or a Peltier junction 132 as shown in Figure 47 of *Bailey, Sr., et al.*

The reference thus reads on the claims.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 21, 22, 31, and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8 through 10, 13, 14, and 21 of *U.S. Patent No. 5,967,225*, issued to Donny Ray Jenkins (same inventive entity as that for the instant application) on October 19, 1999.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claimed inventions is that the claims in the patent additionally

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recite additional elements, such as an enclosure with plural chambers in one of which chambers the pump is disposed.

Nevertheless, omission of an element and its function is obvious if the function of the element is not desired. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and *In re Kuhle*, 526 F.2d553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

In the instant case, it would have been obvious to delete the multi-chambered enclosure for the pump if no such enclosure were essential in order to ensure that the pump and its associated pumping are protected from the environment, for example.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dean (filed November 6, 2000) does not constitute prior art per se, but does show a medical cooling vest including plural interconnected fluid flow passages and an associated temperature control system.

Troyer, Zafred, Scholley (both references), *Arnoth, Horn, Szczesuil et al.* (all six references), *Bailey, Sr., et al.* ('324), and *Gibbs et al.* each discloses a body heating/cooling apparatus including a vest having coolant flow passages and an associated temperature control system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

June 24, 2004


LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753